

U.S. Patent Application Serial No. 10/826,501
Response filed November 27, 2007
Reply to OA dated July 27, 2007

REMARKS

Claims 1 - 16 are currently pending in this patent application, claims 1, 6, 10 and 12 - 16 being independent claims.

Claims 1, 2 and 6 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. It is believed that this Amendment is fully responsive to the Office Action dated July 27, 2007.

Claims 1 - 9 have been objected to due to certain informalities set forth in item 1, page 2 of the outstanding Office Action. The applicants respectfully request reconsideration of these objections.

As indicated above, claims 1, 2 and 6 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention, and in order to correct certain informalities therein, including those pointed out by the Examiner.

Accordingly, the withdrawal of the outstanding objections to the claims is in order, and is therefore respectfully solicited.

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Claims 13 and 14 stand rejected under 35 USC § 101 for the reasons specifically set forth in the second full paragraph in item 2, page 2 of the outstanding Office Action. The applicants respectfully request reconsideration of this rejection.

The applicants submit that in July 1998, the Court of Appeals for the Federal Circuit, in the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn. The patent involved in the *State Street Bank* case, U.S. Patent No. 5,193,056, is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (*e.g.*, in the *State Street Bank* case, which represented “discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price”) constitutes:

- (a) a “practical application of a mathematical algorithm, formula, or calculation,” but
- (b) nevertheless, produces “a useful, concrete and tangible result.”

In the instant case, it is clear that the claimed invention, set forth in each of claims 13 and 14, meets not only item (1), above, but also item (2) in any of the claimed steps recited in the claims.

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In view of the above, the withdrawal of the outstanding rejection under 35 USC § 101 is in order, and is therefore respectfully solicited.

As to the merits of this case, the following rejections are set forth in the outstanding Action:

(1) claims 1 - 4, 6 - 8, 10 and 12 - 16 stand rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969, 003) in view of Hamamura (U.S. Patent No 5, 815, 748);

(2) claims 5 and 9 stand rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969, 003) in view of Hamamura (U.S. Patent No 5, 815, 748) and further in view of Terasaki (U.S. Patent No. 7,119, 843); and

(3) claim 11 stands rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969, 003) in view of Hamamura (U.S. Patent No 5, 815, 748) and further in view of Iida (U.S. Patent No. 5,001, 507).

The applicants respectfully request reconsideration of these rejections.

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The applicants have amended the claims so as to highlight: “a focusing mechanism for moving said optical system to an auto-focusing position or a fixed focus position” in each of claims 1 and 6. The amendments are to clarify a focusing mechanism, support of which can be found in paragraphs [0082] and [0137] in the applicants’ specification, and illustrated in, for example, the applicants’ Figures 1, 14 and 15.

As to the claimed “controller,” now recited in claims 1, 2 and 6, the amendment is made so as to clarify a controller, support of which can be found in the applicants’ specification in paragraph [0006].

More particularly, the claimed “controller,” as now recited in, e.g., claim 1, operates such that:

1. in the case where a shutter operation of the switch is performed during a focusing action of the focusing mechanism due to the switch;
2. the optical system is shifted to a fixed focus position from an auto-focusing position; and
3. a fixed focus image is taken.

It is submitted that Ohnuki does not teach all of the above-mentioned features of the claimed invention.

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With respect to the Ohnuki reference itself, the part cited for “a control part,” such element in Ohnuki is merely described as follows: “in a case where the switch SW2 turns on at a time during the above-described cycle of focus adjustment, and the release interruption occurs, the release operation immediately follows. At the time point of the completion of the exposure preparation, the lens is stopped and the exposure operation is carried out.” See, lines 54 - 59, column 18 in Ohnuki.

As to the above-discussed claimed “controller,” the optical system is shifted to a fixed focus position from an auto-focusing position, and a fixed focus image is taken. As described in the applicants’ specification, the object of the applicants’ invention is to provide “an electronic device which is able to photograph by means of an AF (auto-focusing) function and a PF (pan-focus: a fixed focus) function, to make it possible to select automatically a taken image from a relation between an AF function and a shutter operation, and to give improvement of quickness of taking of an image.” Such structural arrangement is not disclosed or suggested in Ohnuki. The object of quick taking of an image is realized by the above stated claimed structural arrangement.

Such quick taking of an image enables photography in response to various objects, and enables provision of an electric device for improving satisfaction of a user.

The applicants submit that the above-discussed claimed structural arrangements, and the advantages or benefits derived therefrom are not disclosed in the cited prior art references, including

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the primary reference, Ohnuki, and the secondary references, Hamamura, Terasaki, and Iida. Thus, the suggested combined teachings of these references would still fall far short in fully meeting the applicants' claimed invention, as now recited in the amended claims filed herewith. Accordingly, a person of ordinary skill in the art would not have found the applicants' claimed invention, as now recited in the amended claims, obvious under 35 USC § 103(a) based on the teachings of the cited prior art references, singly or in combination.

In view of the above, the withdrawal of the outstanding obviousness rejections under 35 USC § 103(a) is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

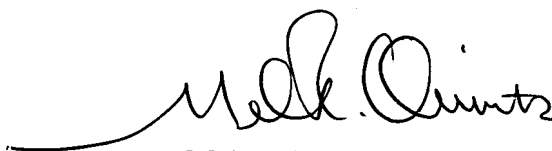
If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP



Mel R. Quintos
Attorney for Applicants
Reg. No. 31,898

MRQ/lrj/ipc

Atty. Docket No. **040075**
Suite 400
1420 K Street, N.W.
Washington, D.C. 20005
(202) 659-2930



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PATENT & TRADEMARK OFFICE

Enclosures: Petition for Extension of Time (one month).

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